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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,582

Applicant(s)

BOEHM ET AL.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/16/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/13/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

The instant application is a continuation-in-part of application no. 10/681,024 filed 10/08/03.

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

2. Claim 12 is objected to because of the following informalities:

in claim 12, line 1, substitute "8" with --1--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

4. Claims 6 and 13 are rejected as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s) or amend the claim(s) to place the claim(s) in proper dependent form. Pfizer, Inc., Pfizer Ireland

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Pharmaceuticals, Warner-Lambert Company, Warner-Lambert Company, LLC, and Warner-Lambert Export, LTD., v Ranbaxy Laboratories Limited and Ranbaxy Pharmaceuticals, Incorporated (Fed Cir, 06-1179, 8/2/2006). Pfizer Inc. v. Ranbaxy Labs., 405 F. Supp. 2d 495 (D. Del. 2005).

The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) (“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.”). Since independent claims 1 and 8 cite limitations including the markush clause “consisting of”, no elements may be included into the markush group as claims 6 and 13 attempt. Because of the aforementioned, claims 6 and 13 fail to further limit claims 1 and 8, respectively.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 8, 14, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gregerson et al. (US 6,702,183) (hereinafter referred to as ‘Gregerson ‘183’).

Gregerson ‘183 teaches:

regarding claims 1 and 15, an actuator (pushbutton 116) assembly for an omnidirectional

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optical code scanner (scanner 100) system and method for reading including illuminating, scanning and decoding at least one optical code within a field of view of the scanning system and oriented in an orientation included in a set of multiple orientations comprising:

means for providing for user selection of a mode selected from the group of modes consisting of: an omnidirectional mode for performing a read operation for reading an optical code oriented in any orientation included in the set of multiple orientations, a restricted omnidirectional mode for performing a read operation for reading the optical code when oriented only in an orientation of a reduced set of the set of multiple orientations; and an aim mode for illumination a target object and disrupting a corresponding read operation (col. 3, lines 4-28 and 57-65);

means for generating a signal indicative of the mode selection (col. 3, lines 11-15, 23-28, and 59-65);

regarding claim 8, an omnidirectional optical code scanner system for reading including illuminating, scanning and decoding at least one optical code within a field of view of the scanning system and oriented in an orientation included in a set of multiple orientations comprising:

an actuator assembly comprising:

means for providing for user selection of a mode selected from the group of modes consisting of: an omnidirectional mode for performing a read operation for reading an optical code oriented in any orientation included in the set of multiple orientations, a restricted omnidirectional mode for performing a read operation for reading the optical code when oriented

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only in an orientation of a reduced set of the set of multiple orientation; and an aim mode for illuminating a target object and disrupting a corresponding read operation; and

means for generation a signal indicative of the mode selection; and

at least one processor (processor 114) comprising means for operating the scanning system in the selected mode in accordance with the signal indicative of the mode selection;

regarding claim 19, a single line scanning system for reading an optical code including illuminating, scanning and decoding at least one optical code within a field of view of the scanning system comprising:

an actuator assembly comprising:

circuitry responsive to user action for providing for selection of a mode selected from the group of modes consisting of: a read mode for performing a read operation for reading an optical code, and an aim mode for illuminating a target object and disrupting a corresponding read operation (col. 3, lines 23-65); and

circuitry for generating a signal indicative of the mode selection (inherently suggested); and

at least one processor comprising means for operating the scanning system in the selected mode in accordance with the signal indicative of the mode selection;

the actuator assemblies and method wherein the scanning system further comprises means for at least one of further processing read operation results and transmitting the read operation results for further processing: and

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wherein disrupting the read operation includes causing the reading results to be unavailable for at least one of the processing and transmitting for further processing (col. 3, lines 23-55); and

the method and the single line scanning system wherein the circuitry is responsive only to user action (action resulting from pressing of pushbutton 116).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 3, 9, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregerson '183 in view of Gregerson et al (US 5,818,025) (hereinafter referred to as 'Gregerson '025').

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The teachings of Gregerson '183 have been discussed above.

Gregerson '183 lacks the teaching of the reduced set as selectable.

Gregerson '025 teaches an assembly, method, and system wherein a user selects a restricted omnidirectional mode for performing a read operation for reading an optical code when oriented only in an orientation of a reduced set of a set of multiple orientations (col. 3, lines 10-16);

wherein the reduced set is selectable (col. 3, lines 10-16); and

wherein the reduced set is selectable via the actuator assembly (col. 3, lines 10-16).

One of ordinary skill in the art would have readily recognized that providing the Gregerson '183 with the selectable reduced set would have been beneficial for saving the energy consumed in creating an omni-directional scan pattern every time an optical code is to be read. Saving energy would eventually cut costs associated with the electrical operation of the scanner and help to prolong the life of the scanner. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Gregerson '183 with the aforementioned teaching of Gregerson '025.

10. Claims 4, 5, 11, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregerson '183 in view of Svetal et al. (US 6,318,634) (hereinafter referred to as 'Svetal').

The teachings of Gregerson '183 have been discussed above.

Gregerson '183 lacks the teaching of a trigger.

Svetal teaches an actuator assembly, method, and system wherein a user selects of a mode (col. 4, lines 14-17);



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wherein the actuator assembly is a single trigger (col. 4, lines 14-17); and

wherein the trigger is a single position trigger (col. 4, lines 14-17).

One of ordinary skill in the art would have readily recognized that providing the Gregerson '183 invention with the trigger of Svetal would have been beneficial since the trigger is a commonly recognized device for signaling the device to which the trigger is attached to perform a function. The trigger would be easy-to-use and ergonomically sensible and efficient in its ease of use. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Gregerson '183 with the trigger as taught by Svetal.

11. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregerson '183/Svetal as applied to claims 5 and 12 above, and further in view of Meyerson et al. (US 5,703,349) (hereinafter referred to as 'Meyerson').

The teachings of Gregerson '183/Svetal have been discussed above.

Gregerson '183/Svetal lack the teaching of a first circuitry responsive to user action and a second circuitry for generating a signal indicative of the mode selection.

Meyerson teaches a first circuitry (trigger circuit 21a) responsive to user action for providing a selection; and

second circuitry (selection circuitry 56) for generating a signal indicative of the mode selection (col. 6, lines 38-45).

One of ordinary skill in the art would have readily recognized that providing the Gregerson '183/Svetal invention with a first and second circuitry would have been beneficial since the individual circuitry may each only perform specific functions thereby possibly allowing

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the circuits to be relatively small in size. Smaller sized circuits may be desired by a scanner manufacturer for their portability and potential to allow the scanner to be small and portable also. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Gregerson '183/Svetal with the aforementioned teaching of Meyerson.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Tamburrini (US 5,962,838) teaches a barcode scanner with manually switchable scan patterns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jamarla A. Franklin  
Examiner  
Art Unit 2876

JAF  
September 27, 2006